



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/585,067

06/29/2006

Hiroyuki Tanaka

Q95248

5100

23373 7590 12/29/2009
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

BUIE-HATCHER, NICOLE M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

12/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No. 10/585,067	Applicant(s) TANAKA ET AL.	
	Examiner NICOLE M. BUIE-HATCHER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,11,12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,11,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 08/27/2009 has been entered. Claims 8, 9, 11, 12, and 14 remain pending. The previous rejection of claim 15 under 35 USC 102(b) as being anticipated by Guschin et al. (US 5,482,695) is withdrawn in light of Applicants cancellation of the claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savinkin et al. (RU 2164524 C1, see Derwent Abstract for citation) as evidenced by Guschin et al. (US 5,482,695) in view of Drobny "Technology of Fluoropolymers", 2001, CRC Press, , pp. 103-104.

Regarding claims 8 and 9, Savinkin et al. discloses a fluorine-containing elastomer comprising a fluorine-containing elastomer and impact detonation diamond graphite which is

Art Unit: 1796

used for a coating (See Derwent Abstract). Since the composition of RU '524 comprises the same components as the claimed material, the coating of RU '524 is a sealing material.

However, Savinkin et al. does not explicitly disclose the particle size of impact detonation diamond graphite. As evidenced by Guschin et al., the size of the diamond after detonation is from 0.004-0.012 μm which meets the claimed range (C1/L21-25, C2/L1-10).

However, modified Savinkin et al. does not disclose fluorine-containing elastomer is a perfluoroelastomer. Drobny teaches perfluoroelastomers are useful as coatings or sealants (P103-104). Savinkin et al. and Drobny are analogous art concerned with the same field of endeavor, namely fluoroelastomeric material for coatings. It would have been obvious to one of ordinary skill in the art at the time of invention to substitute a fluorine-containing elastomer of Savinkin et al. with a perfluoroelastomer of Drobny, and the motivation to do so would have been as Drobny suggests perfluoroelastomers are particularly suited for extreme service conditions, including chemical substances, oxidizers, oils, fuels, acids, and are capable of use at high temperatures (P103).

Regarding claim 11, the recitation of a new intended use (i.e. for a semiconductor manufacturing equipment) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savinkin et al. (RU 2164524 C1, see Derwent Abstract for citation) as evidenced by Guschin et al. (US 5,482,695).

Art Unit: 1796

Regarding claims 12 and 14, Savinkin et al. discloses a fluorine-containing elastomer comprising a fluorine-containing elastomer and impact detonation diamond graphite which is used for a coating (See Derwent Abstract).

However, Savinkin et al. does not explicitly disclose the particle size of impact detonation diamond graphite. As evidenced by Guschin et al., the size of the diamond after detonation is from 0.004-0.012 μm which meets the claimed range (C1/L21-25, C2/L1-10).

However, modified Savinkin et al. does not disclose fluorine-containing elastomer is a perfluoroelastomer. Drobny teaches perfluoroelastomers are useful as coatings or sealants (P103-104). Savinkin et al. and Drobny are analogous art concerned with the same field of endeavor, namely fluoroelastomeric material for coatings. It would have been obvious to one of ordinary skill in the art at the time of invention to substitute a fluorine-containing elastomer of Savinkin et al. with a perfluoroelastomer of Drobny, and the motivation to do so would have been as Drobny suggests perfluoroelastomers are particularly suited for extreme service conditions, including chemical substances, oxidizers, oils, fuels, acids, and are capable of use at high temperatures (P103).

Response to Arguments

Applicant's arguments filed 08/27/2009 have been fully considered but they are not persuasive. The following comments apply:

A) Applicants' argument assertion of unexpected results (page 4) is not persuasive. The arguments of counsel cannot take the place of evidence in the record. See MPEP 716.01(c).

Art Unit: 1796

B) Applicants' argument that there is no disclosure of a sealing material in RU '524 (page 5) is not persuasive. Since the composition of RU '524 comprises the same components as the claimed material, the coating of RU '524 is a sealing material.

C) Applicants' argument that it would be quite difficult for a person skilled in the art to obtain a sealing material such as an O ring from the coating of RU '524 (page 5) is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an O ring or any other molded article) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

D) Applicants' argument that Drobny only discloses molded perfluoroelastomer articles (page 5) is not persuasive. Drobny teaches perfluoroelastomers are useful as **coatings** or sealants (See rejections of claims 8 and 12 above). Therefore, Drobny is not limited to molded articles. Drobny provides the motivation to use perfluoroelastomers for their improved chemical properties as shown above in claims 8 and 12.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1796

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE-HATCHER whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/N. M. B./
Examiner, Art Unit 1796
12/4/2009